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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/619,609	07/16/2003	Kurt Plotz	032745-037	6540

7590 10/02/2006

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EXAMINER	
TORRES VELAZQUEZ, NORCA LIZ	
ART UNIT	PAPER NUMBER
1771	

DATE MAILED: 10/02/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/619,609	PLOTZ, KURT	
	Examiner	Art Unit	
	Norca L. Torres-Velazquez	1771	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *July 28, 2006 by BPAI*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1,3-11,13-16 and 32-34* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1,3-11,13-16 and 32-34* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☒ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☒ Certified copies of the priority documents have been received in Application No. 09/619,529.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

- Per recommendation of the Board of Patent Appeals and Interferences in their Decision and Remand mailed July 28, 2006, prosecution is hereby reopened to address issues identified thereby on pages 6 and 7 of the Decision and Remand.

Claim Rejections - 35 USC § 102

> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

2. Claims 1, 4, 9-10, 13 and 15-16 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over GREISER et al. (US 5,017,426).

GREISER et al. teaches a laminate "suitable as a carrier web for roofing and sealing sheets that comprises a preconsolidated synthetic fiber web and preconsolidated mineral fiber web which are bonded to each other by needling." (Column 1, lines 48-52) Greiser teaches that "[p]referred mineral fiber webs are glass fiber webs..." See column 1, line 66. These "roofing and sealing sheets are usually coated with bitumen on one or both sides, but can also have a coating made from elastomers or plastomers," thus meeting the claimed requirement for one or more layers coated on a glass fiber side of the carrier web. See column 1, lines 10-15. The reference teaches that the synthetic fiber web preferably comprises polyester fibers. (Col. 1, lines 53-54)

The reference further teaches that the needling is carried out in such a way that the needles first enter the synthetic fiber web and then penetrate through the material fiber web underneath and teaches pulling the synthetic fibers through the mineral fiber web. The needling should comprise 10 to 100 stitches/cm^2, preferably between 20 and 50 stitches/cm^2. (Col. 2, lines 13-22). It is reasonable to presume that "part of the organic synthetic fibers penetrate through the fiberglass mat and lie adjacent to a side of the fiberglass containing mat that is opposite to the organic nonwoven mat" as recited in claim 1 is inherent to the invention of GREISER et al. since it uses a similar needling method to that used to produce the present invention. The burden is upon Applicant to prove otherwise. *In re Fitzgerald* 205 USPQ 594. In addition, the presently claimed property of having the organic fiber penetrate through the fiberglass mat and lie adjacent to a side of the fiberglass-containing mat would obviously have been present one the GREISER et al. product is provided. Note In re Best, 195 USPQ at 433, footnote 4 (CCPA 1977) as to the providing of this rejection made above under 35 USC 102.

Claim Rejections - 35 USC § 103

3. Claims 5-8, 11, 14 and 33 are rejected under 35 U.S.C. 103(a) as being unpatentable over GREISER et al. as applied above, and further in view of HEIDEL et al. (US 5,171,629).

HEIDEL et al. discloses a carrier web for roofing and sealing webs that consists of a glass fiber mat and a mat of synthetic fibers which are needled to one another and end-consolidated with a polymer-free low-formaldehyde melamine-formaldehyde precondensate. The glass fiber mat can be preconsolidated using polymer binders or melamine resins. (Col. 2, lines 13-17) The synthetic fiber nonwoven can be built up from staple fibers or from continuous fibers. Examples of synthetic fibers suitable are aliphatic and aromatic polyamides,

polyacrylonitrile and in particular polyester fibers. The reference teaches pre-consolidation of the synthetic fiber nonwoven by a calendering process. (Refer to Col. 2, lines 25-49)

Since both references are directed to carrier webs for roofing and sealing webs, the purpose disclosed by HEIDEL et al. would have been recognized in the pertinent art of GREISER et al.

It would have been obvious at the time the invention was made to a person having ordinary skill in the art to modify the organic synthetic fibers mat and the fiberglass containing mat and provide them with alternative preconsolidation processes and the different embodiments (ie. staple fiber or filamentous nonwoven synthetic fibers mat) with the motivation of producing a carrier web with high mechanical stability, including at elevated temperatures, that is combined with very good burning properties as disclosed by HEIDEL et al. (Col. 2, lines 3-8)

4. Claims 3 and 32 are rejected under 35 U.S.C. 103(a) as being unpatentable over GREISER et al. as applied above, and further in view of NIEMINEM et al. (US 5,458,960).

NIEMINEM et al. relates to a flexible base web for construction covering (i.e. floor or wall covering). (Refer to Col. 1, lines 4-16) The web has a main layer that comprises mainly of mineral also includes a surface layer of polyethylene, polypropylene or polyester fibers bonded to the main layer by needling. (Col. 8, lines 5-10)

GREISER et al. discloses the claimed invention except that it uses polyester fibers instead of polypropylene fibers, NIEMINEM et al. shows that polypropylene fiber is an equivalent structure known in the art. Therefore, because these two synthetic fibers were art-recognized equivalents at the time the invention was made, one of ordinary skill in the art would have found it obvious to substitute polyester for polypropylene.

With regards to claim 32, NIEMINEM et al. teaches the use of polyvinyl chloride coating to protect the covering material from weather conditions. Since both references are directed to similar applications (wall and floor coverings), the purpose disclosed by NIEMINEM et al. would have been recognized in the pertinent art of GREISER et al.

It would have been obvious at the time the invention was made to a person having ordinary skill in the art to modify the carrier web of GREISER et al. and provide it with a coating with the motivation of providing the material with good weather resistance and processability, as well as fire resisting properties when a chlorinated coating is used as disclosed by NIEMINEM et al. (Col. 6, lines 56-61)

5. Claim 34 is rejected under 35 U.S.C. 103(a) as being unpatentable over GREISER et al. in view of HEIDEL et al. (US 5,171,629) as stated above and further in view of FRANKENBURG et al. (US 4,569,088).

GREISER et al. and HEIDEL et al. disclose the claimed invention except for using mechanical needling instead of hydraulic needling, FRANKENBURG et al. shows that hydraulic needling is an equivalent process known in the art. Therefore, because these two types of needling were art-recognized equivalents at the time the invention was made, one of ordinary skill in the art would have found it obvious to substitute the mechanical needling of GREISER et al. and HEIDEL et al. for the hydraulic needling of FRANKENBURG et al.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Norca L. Torres-Velazquez whose telephone number is 571-272-1484. The examiner can normally be reached on Monday-Thursday 8:00-5:00 pm and alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Terrel Morris can be reached on 571-272-1478. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

September 21, 2006

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